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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/648,069 | 08/26/2003 | Neelima Atluri | NAI001 | 3378 |
| 28848 | 7590 | 09/23/2008 | EXAMINER | |
| TOPE-MCKAY & ASSOCIATES | | | SILBERMANN, JOANNE | |
| 23852 PACIFIC COAST HIGHWAY #311 | | | | |
| MALIBU, CA 90265 | | | ART UNIT | PAPER NUMBER |
| | | | 3611 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 09/23/2008 | PAPER |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEELIMA ATLURI

Appeal 2008-2076
Application 10/648,069
Technology Center 3600

Decided: September 23, 2008

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Atluri (Appellant) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4 and 6-31. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The claimed invention relates to an illustrative drug card.

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An illustrative drug card, comprising:

an illustrative portion, where the illustrative portion includes a list of medications used by a patient, with the list represented by an illustration of each medication;

a symbol-aided instruction on when to administer a medication listed in the list of medications; and

a symbol-aided instruction on how to administer a medication listed in the list of medications.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|----------|--------------|---------------|
| Will | US 4,593,819 | Jun. 10, 1986 |
| Mayfield | US 5,261,702 | Nov. 16, 1993 |
| Coe | US 5,393,100 | Feb. 28, 1995 |
| Schutten | US 6,575,297 | Jun. 10, 2003 |

THE REJECTIONS

The following rejections are before us for review:

Claims 1-4, 6-9, 14-18, and 23-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coe and Mayfield.

Claims 10-12, 19-21 and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coe, Mayfield, and Schutten.

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coe, Mayfield, and Will.

Claims 22 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coe, Mayfield, Schutten, and Will.

for Claim 1

The Appellant argues that neither Coe nor Mayfield teach a symbol-aided instruction on how to administer a medication. (App. Br. 6 and Reply Br. 2.) The Appellant argues that there is no motivation or suggestion to combine Coe and Mayfield because the areas 54 are designed for the physician to write or type how to administer the medication; and furthermore, such a modification would render Coe unsatisfactory for its intended purpose and would change the principles of Coe's operation. (App. Br. 7.) The Appellant argues that the claimed invention is directed to an improvement in a "crowded art" and, accordingly, even a small improvement should be patentable. (App. Br. 8.) The Appellant argues that the key difference between Coe and Mayfield and the present invention is fixed symbols are used in the present invention whereas transient symbols are used in Coe and Mayfield. (*Id.*)

for Claim 2

The Appellant argues that “modifying either of the inventions taught by the Coe patent or the Mayfield patent to be foldable, wallet-sized booklet that is substantially planar in form would render the prior art of both inventions unsatisfactory for their intended purposes.” (App. Br. 9 and Reply Br. 3.) The Appellant argues “[b]y its very nature, the invention of the Coe patent is unable to be modified as a wallet-sized booklet that is substantially planar in form.” (App. Br. 10, Emphasis original.) The Appellant argues that “[a] similar case exists with the Mayfield patent. ... Based on the need for a rigid chart that can be affixed with a surface, creating a chart that is foldable into a substantially planar form would likely render the chart unsuitable for its intended purpose.” (*Id.*)

for Claim 3

The Appellant submits “that Claim 3 is also patentable over the cited prior art, at least through its dependence upon an allowable base claim.” (App. Br. 11.)

for Claims 4, 14, and 23

The Appellant submits “that Claim 4, 14, and 23 are also patentable over the cited prior art, at least through its dependence upon an allowable base claim.” (*Id.*)

for Claims 6, 7, 15, 16, 24, and 25

The Appellant argues that the symbols disclosed in Mayfield are not “being used to represent a particular time of day.” (App. Br. 12 and Reply Br. 3.) The Appellant further argues that Mayfield “is to be contrasted with

the present invention, where the symbol-aided instruction on when to administer a medication includes a symbol that actually represents a time of a day, such as a sun, moon, and stars. (*Id.*)

for Claims 8, 17, and 26

The Appellant argues that “[n]owhere in the prior art are any references to a symbol that indicates what to administer with the medication.” (App. Br. 13 and Reply Br. 4.)

for Claims 9, 18, and 27

The Appellant argues that “[n]owhere in the prior art are [there] any references to symbols such as liquid and/or food.” (App. Br. 13 and Reply Br. 4.)

Claim groupings, see 37 C.F.R § 41.37(c)(1)(vii)

The Appellant argues claims 1, 2, and 3 separately.

The Appellant argues claims 4, 14, and 23 as a group. We select claim 4 as representative and claims 14 and 23 will stand or fall with claim 4.

The Appellant argues claims 6, 7, 15, 16, 24, and 25 as a group. We select claim 6 as representative and claims 7, 15, 16, 24, and 25 will stand or fall with claim 6.

The Appellant argues claims 8, 17, and 26 as a group. We will select claim 8 as representative and claims 17 and 26 will stand or fall with claim 8.

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The Appellant argues claims 9, 18, and 27 as a group we will select claim 9 as representative of the group and claims 18 and 27 stand or fall with 9.

The Appellant argues claims 10-12, 19-21, and 28-30 as a group. We will select claim 10 as representative and claims 11, 12, 19-21, and 28-30 will stand or fall with claim 10.

The Appellant argues claim 13 separately.

The Appellant argues claim 22 and 31 as a group. We will select claim 22 as representative and claim 31 will stand or fall.

ISSUES

The issues before us in this appeal are whether the Appellant demonstrates that the Examiner erred in rejecting:

claims 1-4, 6-9, 14-18, and 23-27 as being unpatentable over Coe and Mayfield.

claims 10-12, 19-21 and 28-30 as being unpatentable over Coe, Mayfield, and Schutten.

claim 13 as being unpatentable over Coe, Mayfield, and Will.

claims 22 and 31 as being unpatentable over Coe, Mayfield, Schutten, and Will.

The issues before us turn on whether Coe, Mayfield, Schutten, and Will describe the claimed subject matter and would the combination of Coe,

Mayfield, Schutten, and Will render any of their inventions unsatisfactory for their intended purposes.

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Coe describes an illustrative drug card; see Figure 2, sheet 30. Coe's card contains an illustrative portion (stickers 42) that includes a list of medications used by the patient. Coe's card provides instructions 54 on when to administer a medication listed on the list, see Figure 2 "One in the morning." Coe's card provides instructions on how to administer a medication listed on the list, see Figure 2 "Two after meals." The instructions can be handwritten or typewritten. (Coe, Fig. 2, col. 3, ll. 49-62.) Coe describes on the opposite side of sheet 30 there is a large area 58 where special instructions can be inserted concerning exercise, meals, the drinking of liquids. (Coe, Fig. 3, col. 4, ll. 36-39.) Also, Coe describes on the opposite side of sheet 30 a list of general information 56 can be included, "The Do's and Dont's [sic: Don'ts] of Prescription Medicine." (Coe, Fig. 3, col. 5, ll. 5-32.)
2. Coe's sheet 30 is designed to be torn from pad 28, (Coe, col. 3, ll. 49-50.) Coe describes an objective of the invention "is to provide a method of scheduling medication which provides graphic and written instructions to a patient, particularly an elderly patient who must take

multiple medications over the course of time.” (Coe, col. 2, ll. 22-26.) Accordingly, the sheet 30 is sized to be given to a patient to assist the patient in the scheduling of medication.

3. A “sheet” is defined as “a usu[ally] rectangular piece of paper.” *Webster’s New Collegiate Dictionary* 1084 (9th Ed. 1987). One of ordinary skill in the art would understand that a sheet, which is usually defined as a rectangular piece of paper, is readily capable of being folded down to a wallet sized booklet having a substantially planar form.
4. Mayfield describes a medication management system for a patient. (Mayfield, col. 2, ll. 6-35.) A preferred embodiment of this system is in the form of a chart 10. The chart 10 is preferably constructed from a plastic laminate; however, paper is suitable. (Mayfield, col. 4, ll. 33-35.) On the left side of the chart 10 a column 12 is disposed with each of the patient’s medication is listed. Column 12 contains a number of columnar boxes where each medicine to be taken by the patient can be listed. Adjacent to each columnar box is an associated color-coded and shaped symbol. Across the top of chart 10 is a section 16 identified as “Times.” Section 16 lists the appropriate dosage times-of-the-day. (Mayfield, col. 5, ll. 34-48.)
5. Mayfield describes providing medication marking elements 18 that correspond to the identical color-coded symbols 14 on chart 10. (Mayfield, col. 5, ll. 56-60.) Thus, chart 10 provides a reminder to take only the prescribed medications at the proper time by matching the stickers 22 on the bottles of medicine (see Figure 4-6) to the

colored shaped marking elements 18 and symbols 14 on the chart 10. (Mayfield, col. 5. l. 65 to col. 6, l. 2.) Accordingly, Mayfield describes instructions on when to administer a medication on a list of medications in the form of a symbol.

6. Mayfield describes chart 10 may further have a “Notes” section 20. This notes section 20 provides general information regarding the various medications 12, e.g. “take with food,” “no alcohol.” (Mayfield, col. 6, ll. 12-16.) Accordingly, Mayfield describes instructions on how to administer a medication on a list of medication.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might

be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

Claim 1

We are not persuaded by the Appellant’s arguments that the combination of Coe and Mayfield fail to describe instructions on how to administer a medication in symbol form. Coe’s card provides instructions on how to administer medications. (Fact 1.) Mayfield’s chart also provides instructions on how to administer medications. (Facts 4-5.) Mayfield’s manner of providing instruction is through an association of a symbol to a particular medication. (Facts 4-5.) Accordingly, the combination of Coe and Mayfield describe instructions on how to administer medications in symbol forms.

Moreover, the Supreme Court, in *KSR*, has reaffirmed its principles on obviousness based on its precedent within *Hotchkiss*, *Graham*, *Adams*, and *Sakraida*: “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739. Such is the case with respect to the instant claimed subject matter, which is a combination of familiar elements in the art and does no more than yield a predictable result of providing a card with indicia thereon to instruct a patient how and when to administer medication. Coe describes the familiar elements of the drug card, the illustrative portion of the card, and instructions on when and how to administer the medications listed. (Fact 1.) Mayfield describes familiar

elements of a chart listing medications, times to take the medications, and symbols to associate with the medications in order to take the proper medicine at the proper time of the day. (Fact 2.) The difference between the claimed subject matter and the combination of Coe and Mayfield is that the claimed subject matter combines familiar elements that are separately described in Coe and Mayfield. As such, the claim is combining familiar elements (card and indicia) in the prior art (Coe and Mayfield) according to known methods of fabricating such familiar elements. We do not see anything unpredictable from the result of combining Coe and Mayfield, nor has the Appellant come forth with evidence of unpredictability by combining these familiar elements. Accordingly, such a combination is obvious to one of ordinary skill in the art at the time of the invention.

We are not persuaded by the Appellant's argument that there is no motivation to combine Coe and Mayfield because Coe's area 54 is designed for the physician to write or type how to administer medications listed on the illustrative portion of sheet 30. While Coe's area 54 is capable of being used for the physician to handwrite how to administer the medication, there is not a requirement in Coe that this is the only way a physician could convey the instructions on how to administer the medication, as evidence by Coe describing the physician could have the instructions typewritten. (Fact 1.) If Coe contemplated the physician could have the instructions typewritten, instead of handwritten, then other forms of inserting the instructions are likewise contemplated, such as the insertion of pre-printed labels and the like. A reference is not limited to its preferred embodiment, but must be evaluated for all of its teachings, including its teachings of non-preferred embodiments. *In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979). While the

preferred embodiment is shown in Figure 2 has handwritten instructions, Coe describing the physician could have the instructions typewritten (Fact 1) evidences Coe contemplates other embodiments that do not require the physician to handwrite the instructions.

We are not persuaded by the Appellant's argument that applying the teachings of Mayfield to Coe would render Coe unsatisfactory for its intended purpose and would change the principles of Coe's operation. Coe's intended purpose is to "provide graphic and written instructions to a patient, particularly an elderly patient who must take multiple medications over the course of time." (Fact 2.) We do not see how providing instructions in the form of symbols changes the intended purpose or principles of operation in Coe. Moreover, we find the Examiner has articulated an apparent reason with logical underpinning for modifying Coe with Mayfield, "to provide clear instructions for patients with poor eyesight." (Answer 3.)

We are not persuaded by the Appellant's argument that the claimed invention is directed to an improvement in a "crowded art" and, accordingly, even a small improvement should be patentable. Not only is there insufficient evidence of record to support the contention that this is a "crowded art" but, even if there were, the criterion on which patentability must be resolved is obviousness under 35 U.S.C. § 103. *See In re Saari*, 386 F.2d 909, 913 (CCPA 1967). There is no "crowded art" exception in § 103. On this basis, we are satisfied that the combined teachings of Coe and Mayfield establish a *prima facie* case of obviousness with respect to claim 1.

We are not persuaded by the Appellant's argument between the present invention and the prior art is that fixed symbols are used in the

present invention and transient symbols are used in the prior art. Claim 1 does not require “fixed symbols.” Claim 1 requires symbol-aided instructions on when and how to administer medication. The claim broadly encompasses both fixed and transient symbols. Moreover, the Appellant’s argument focuses on the intermediate products of Coe and Mayfield. The final product and purposes of Coe and Mayfield is to provide instructions on when and how to administer medications to patients. In Coe, the physician gives the patient a final product of sheet 30 that lists the medications and the instructions. In Mayfield, once the medications are known and the orders are written, the daily schedule is set, and thus fixed, until new orders are provided.

Accordingly, we will sustain the Examiner’s rejection of claim 1.

Claim 2

We are not persuaded by the Appellant’s argument that modifying either Coe or Mayfield to be a foldable, wallet-sized booklet would render both unsatisfactory for their intended purposes. Again, the intended purpose of Coe is to provide graphic and written instructions to a patient. In order to fulfill that purpose, the physician in Coe provides the patient with a sheet 30. (Fact 2.) A sheet is usually a rectangular piece of paper. (Fact 3.) We find one of ordinary skill in the art would understand that the sheet 30 in Coe is readily capable of being folded down to a wallet sized booklet having a substantially planar form. (Fact 3.) Moreover, we are not persuaded by Appellant’s argument that Mayfield needs to be rigid to achieve being affixed to a surface. Figure 10 in Mayfield shows the chart 10 curled. Mayfield describes the preferred embodiment is a plastic laminate; in

addition, the chart could be made from paper. (Fact 4.) A reference is not limited to its preferred embodiment (citation omitted). Accordingly, we find that Mayfield could be folded into a substantially planar form based on the disclosure of a non-preferred embodiment being constructed from paper.

Accordingly, we will sustain the Examiner's rejection of claim 2.

Claim 3

The Appellant has made arguments with respect to claim 3 that simply state that Coe and Mayfield do not disclose or suggest certain claimed features and relies on the same arguments presented for claim 1. (App. Br. 11.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. In addition, the Appellant relies on the argument made against the rejection of claim 1 and given that we find those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion with regard to the arguments as they apply to the rejection of claim 3; that is, we find them unpersuasive as to error in the rejection. Accordingly, we will sustain the Examiner's rejection of claim 3.

Claim 4

As with claim 3, the Appellant has made arguments with respect to claim 4 that simply state that Coe and Mayfield do not disclose or suggest certain claimed features and relies on the same arguments presented for claim 1. (App. Br. 11.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the

claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. In addition, the Appellant relies on the argument made against the rejection of claim 1 and given that we find those arguments unpersuasive as to error in the rejection of claim 4, we reach the same conclusion with regard to the arguments as they apply to the rejection of claim 3; that is, we find them unpersuasive as to error in the rejection. Accordingly, we will sustain the Examiner’s rejection of claim 4.

Claim 6, 7, 15, 16, 24, and 25

We are not persuaded by the Appellant’s arguments: 1) that the symbols disclosed in Mayfield are not “being used to represent a particular time of day” (App. Br. 12 and Reply Br. 3), and 2) that Mayfield “is to be contrasted with the present invention, where the symbol-aided instruction on when to administer a medication includes a symbol that actually represents a time of a day, such as a sun, moon, and stars (*Id.*) show an error in the Examiner’s case of *prima facie* obviousness because the arguments are not commensurate in scope to what is claimed. Claim 6 recites the illustrative drug card’s instruction on when to administer the medication “includes a symbol representing a time of day” (Claim 6); not representing a particular time of day such as morning, midday, or evening. As such, the prior art has to describe a correlation between a symbol and a time of day in order to meet the claimed subject matter within claim 6. Mayfield’s symbols are used to identify what time to take the medicine associated with the symbol. For instance, as shown in Figure 2, the symbol “A” is placed in the located on the chart that represents taking the medicine “MOTRIN” at noon. As such,

Mayfield describes instructions that include a symbol representing a time of day.

Accordingly, we will sustain the Examiner's rejection of claims 6, 7, 15, 16, 24, and 25.

Claims 8, 17, and 26

The Appellant has made an argument with respect to claim 8 that simply state that nowhere does the prior art disclose or suggest the claimed features of claim 8. (App. Br. 13.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. Accordingly, we will sustain the Examiner's rejection of claims 8, 17, and 26.

Claims 9, 18, and 27

As with claim 8, the Appellant has made an argument with respect to claim 9 that simply state that nowhere does the prior art disclose or suggest the claimed features of claim 9. (App. Br. 13.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. Accordingly, we will sustain the Examiner's rejection of claims 9, 18, and 27.

Claims 10-12, 19-21, and 28-30

The Appellant has made arguments with respect to claim 10 that simply state that Coe and Mayfield do not disclose or suggest certain claimed features and relies on the same arguments presented for claim 1. (App. Br. 13.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. In addition, the Appellant relies on the argument made against the rejection of claim 1 and given that we find those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion with regard to the arguments as they apply to the rejection of claim 10; that is, we find them unpersuasive as to error in the rejection. Accordingly, we will sustain the Examiner's rejection of claims 10-12, 19-21, and 28-30.

Claim 13

The Appellant has made arguments with respect to claim 13 that simply state that Coe and Mayfield do not disclose or suggest certain claimed features and relies on the same arguments presented for claim 1. (App. Br. 13-14.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. In addition, the Appellant relies on the argument made against the rejection of claim 1 and given that we find those arguments unpersuasive as to error in the rejection of claim 13, we reach the same conclusion with regard to the arguments as they apply to the rejection of claim 1; that is, we

find them unpersuasive as to error in the rejection. Accordingly, we will sustain the Examiner's rejection of claim 13.

Claim 22 and 31

The Appellant has made arguments with respect to claim 22 that simply state that Coe and Mayfield do not disclose or suggest certain claimed features and relies on the same arguments presented for claim 1. (App. Br. 14.) A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. In addition, the Appellant relies on the argument made against the rejection of claim 1 and given that we find those arguments unpersuasive as to error in the rejection of claim 22, we reach the same conclusion with regard to the arguments as they apply to the rejection of claim 1; that is, we find them unpersuasive as to error in the rejection. Accordingly, we will sustain the Examiner's rejection of claims 22 and 31.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting:

claims 1-4, 6-9, 14-18, and 23-27 as being unpatentable over Coe and Mayfield.

claims 10-12, 19-21 and 28-30 as being unpatentable over Coe, Mayfield, and Schutten.

claim 13 as being unpatentable over Coe, Mayfield, and Will.

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claims 22 and 31 as being unpatentable over Coe, Mayfield, Schutten, and Will.

DECISION

The Examiner's decision to reject claims 1-4 and 6-31 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

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